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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,225	03/27/2001	Nobuhiro Azuma	1614.1157	7935

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EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/817,225

Applicant(s)

AZUMA, NOBUHIRO

Examiner

Tan Dean D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

The amendment filed 4/5/04 has been entered.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 2, 1 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claim 2 is directed to a "method for business deal information management", which is not within one of the classes of invention set forth in § 101.

The "method for business deal information management" comprising the steps of:

"(a) receiving accurate information from a user terminal indicating whether a plurality of items, which are included in real estate purchase information supplied from the registered number are accurate; and  
(b) adding a predetermined number of points to the points attributed to the registered member for each of the plurality of items confirmed to be accurate",  
are merely an abstract idea and do not produce a useful, tangible, concrete results.

The “method for business deal information management” comprising the steps of (a)-(b) as shown fail to overcome the 2-prong test:

- 1) merely an abstract idea and
- 2) does not reduce to a practical application in the Technological arts,  
are therefore are found to be non-statutory.

Claim 1, “A business deal information system”, which comprises 4 elements “a business information reception unit, registered member point file, confirmation information reception unit, a point adder unit”, as shown, are merely elements containing abstract idea and does not reduce to a practical application in the Technological arts (involving computer or electronic network) and are therefore are found to be non-statutory.

***Claim Rejections - 35 USC § 112***

3. **Claim 1 is rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. 1) It's not clear the relationship between the 1<sup>st</sup> element of “business information reception unit” to the 3<sup>rd</sup> element of “confirmation information reception unit” that receives accuracy information from a user terminal. What is the relationship between the information of 1<sup>st</sup> element and the information of 3<sup>rd</sup> element? What is the relationship between the “registered member” and “user terminal”? The preamble calls for “a business deal information system” but there is no element talked about the “business deal” is carried out.

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4. **Claim 2 is rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble calls for “a business deal information management method” but there is no steps talked about how the “business deal” is carried out.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 2, 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over ENGBERG (US 2003/015 8960).**

**As for Independent claim 2**, ENGBERG discloses a method for establishing a privacy communication path in business transaction (deal) management comprising the steps of:

a) develop a communication path between two legal entities (buyer, trusted parter (agent), and/or seller) for potential business transaction wherein the 2<sup>nd</sup> legal entity receives information from a user terminal wherein the information contains plurality of items which are normally included in purchase information supplied from a member (or 1<sup>st</sup> entity), {see [0021, 0027, 0046, 0069, 0070]},

b) awarding the customer (adding loyalty points to a joint program) using the customer loyalty program if the communication results cross-company linkability and the

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collection of customer profile information {see [0084, 0085, 0086]} or in suggestive selling or business transaction between the two parties {see [0193, 0194]}. See also Figs. 18 and 27.

As for the limitation of registered member, this is fairly taught in {[0856-0859, 0329-0332, 0351-0352]} wherein ENGBERG shows the general teachings of “membership and community services” which covers membership management, fee, community services, registration.

As for the limitation of awarding the member with points when the information is accurate, this is inherently included in the teaching of ENGBERG above especially in {[0083-0086]} wherein the information in the customer profile is assumed to be accurate so the company can make use of the data and meet the client needs so a transaction or a deal can occur.

As for the limitation of “items which are included in a purchase information, wherein the purchase is in real estate”, ENGBERG discloses purchase information involving service performed in a physical or electronic market, such as auction, trade portal, stock exchanger, commercial transaction between two parties [0069, 0070], legal commitments such as trade of goods or payment for an item which involve a contract, etc. [0076, 0077], or financial business, insurance, retail [0872], etc. which would read over real estate since this is a legal commitment and/or financial business. Alternatively, it would have been obvious to apply to other equivalent or well known legal commitment service or financial business such as real estate as mere applying to other similar business service to achieve similar results, absent evidence of unexpected

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results. Note that the type of business transaction is not critical to the scope of the claimed invention which deals with management of business deal information which can be applied to any type of business, especially legal commitments.

**As for Independent claim 1**, which is an apparatus to carry out the same steps as shown in independent method claim 2 above, it is rejected for the same rejections and locations as shown in claim 2 above. Alternatively, the set up of an equivalent system to carry out the step of claim 2 is within the skill of the artisan and would have been obvious.

In summary, the method and system of ENGBERG for establishing a privacy communication path between seller, trusted party (agent), and/or buyer comprising a worldwide communication system, i.e. Ecommerce or on the Internet, having database containing customer profile or interest lists or wish list {see [0795, 0796]} and loyalty program awarding points to the customer if the communication results cross-company linkability and the collection of customer profile information {see [0084, 0085, 0086]} or in suggestive selling or business transaction between the two parties {see [0193, 0194]} read over the claimed invention as shown in claims 2 and 1. The various immaterial variations or modifications, i.e. the type of business deal, type of points earned or loyalty program, etc., is not critical to the scope of the invention, and would have been obvious to a skilled artisan, absent evidence of unexpected results. This is also confirmed on the specification page 13, lines 26-30.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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8. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

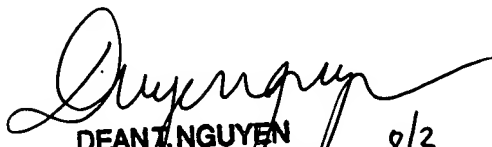
Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn

August 3, 2004

  
DEAN T. NGUYEN  
PRIMARY EXAMINER  
8/3  
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